

REMARKS

The amendments shown above and these Remarks are made in reply to the Office Action mailed March 4, 2009. Claims 50-85 were examined. Claims 86-98 have been withdrawn. Applicant has cancelled claims 56 and 85, and amended claims 50 and 80. Reconsideration is respectfully requested.

I. SUMMARY OF THE EXAMINER'S ACTIONS

In the Office Action mailed March 30, 2009, the Examiner:

- required affirmation of applicant's provisional election;
- objected to the Drawings;
- rejected claim 80 under §112, second paragraph;
- rejected claim 85 as unpatentable under § 102(b);
- rejected claims 50-51, 56-57, 61, 71-79 and 81-84 as unpatentable under § 103(a) over U.S. Patent No. 5,562,979 ("*Easterlow*") in view of U.S. Patent No. 5,942,324 ("*Chu*");
- rejected claims 52-55 and 80 as unpatentable under § 103(a) over the combination of *Easterlow* and *Chu* as applied to claim 50, and further in view of U.S. Patent No. 6,579,397 ("*Spain*");
- rejected claims 56 and 71 as unpatentable under § 103(a) over the combination of *Easterlow* and *Chu* as applied to claim 50, and further in view of European Patent No. 0556449 ("*Kashiwagi*");
- rejected claims 58-59 as unpatentable under § 103(a) over the combination of *Easterlow* and *Chu* as applied to claim 50, and further in view of U.S. Patent No. 6,106,759 ("*Jarrard*");
- rejected claim 60 as unpatentable under § 103(a) over the combination of *Easterlow* and *Chu* as applied to claim 50, and further in view of U.S. Patent No. 6,000,922 ("*Wagner*");
- rejected claims 62-66 and 68-69 as unpatentable under § 103(a) over the combination of *Easterlow* and *Chu* as applied to claim 50, and further in view of WIPO Publication No. WO2002/090002 ("*Phillips*");

- rejected claim 67 as unpatentable under § 103(a) over the combination of *Easterlow* and *Chu* as applied to claim 64, and further in view of the English Abstract of Japanese Patent No. 01-259916 (“*Kiichi*”); and
- rejected claim 70 as unpatentable under § 103(a) over the combination of *Easterlow* and *Chu* as applied to claim 50, and further in view of U.S. Patent Publication No. 2003/0189475 (“*Blume*”).

II. SPECIFIC RESPONSE TO THE EXAMINER’S ACTIONS

A. Affirmation of Election

In response to the Examiner’s restriction requirement, applicant affirms its election of Group I, claims 50-85.

B. Objections to Drawings are Overcome

In response to the Examiner’s objections to the drawings, applicant has provided two replacement sheets including changes to Figs. 1 and 5. The changes are made for consistency with the specification, as follows: reference character 42 is deleted from Figs. 1 and 5; and reference characters 24’ and 24’a are changed to 24 and 24a, respectively, in Fig. 5.

With regard to the reference character 19a in Figs. 5-8, applicant notes that this reference character is explicitly mentioned in the specification at page 17, line 12.

C. Section 112 Rejection Is Overcome

The Examiner rejected claim 80 as indefinite. Applicant has amended the claim as shown above, consistent with the Examiner’s suggestion on page 5 of the Office Action, and submits that this ground of rejection is overcome.

D. Section 102 Rejection Is Moot

The Examiner rejected claim 85 as anticipated by *Kuroda*, however, applicant has cancelled this claim thereby rendering the rejection moot.

E. Section 103 Rejections Are Traversed or Overcome

The Examiner rejected independent claim 50 as obvious over the combination of *Easterlow* and *Chu*. Applicant respectfully traverses the rejection, but has

amended claim 50 for enhanced clarity by incorporating the limitations from claim 56. Claim 56 was rejected as obvious over the combination of *Easterlow* and *Chu*, but was also rejected as obvious over the combination of *Easterlow*, *Chu* and *Kashiwagi*.

The *Easterlow* reference is the U.S. equivalent of GB 2280401, which is discussed in paragraphs 7-9 of applicant's specification. *Easterlow* appears to disclose a dual injection process wherein the outer layer may include metal flakes for providing a metallic paint finish. However, there is no teaching or suggestion within *Easterlow* of using a magnetic field in order to manipulate and orient the metal flakes, as acknowledged by the Examiner. (See Office Action at p. 7). Thus, although it discloses a dual injection process, *Easterlow* by itself is not particularly relevant.

The Examiner alleges that the combination of *Chu* with *Easterlow* renders claims 50 and 56 obvious, but applicant respectfully disagrees.

Chu discloses a method of manufacturing a colored wing mirror by producing a colored injection-molded housing and then spray coating the housing with a substantially transparent layer. The spray coating may include metallic particles which are then manipulated with a magnetic field so as to improve the appearance of the wing mirror. More specifically, the magnetic field is used to orient the metallic particles such that they are arranged parallel to the exterior face of the housing. (See *Chu* at col. 8:7-14).

However, *Chu* discloses a spray painting process, not a dual injection process, and on that basis, applicant considers *Chu* not particularly relevant, and also, not properly combined with *Easterlow*. The Examiner has not provided any basis for combining the use of metal particles in a spray painting process as disclosed in *Chu* with the injection molding process of *Easterlow*.

Metal particles are difficult to use in a spray painting process. It is more difficult for an exterior spray coating to be adhered to the housing than it is to provide adherence between two co-molded layers. In addition, the spray coating is only able to be formed as a very thin layer, i.e., on the order of 25-50 microns (see *Chu* at col. 6:6-13), and thus, the thin layer does not provide much protection to the underlying housing or substrate.

The teaching of *Chu* is intended to eliminate or vastly simplify the conventional painted coating by producing a colored housing and then spraying a

substantially transparent coating over it. (See the Background section of *Chu*). Accordingly, *Chu* is specifically directed to a spray coating process, and not to a dual injection process. Neither *Chu* nor *Easterlow* recognizes that magnetic particles can be provided in the injection molded layer and then magnetically manipulated within the molded layer itself.

Thus, since claim 50 as amended explicitly requires that at least one of the materials injected into the mold includes magnetic particles, and further, that one or more magnetic fields is applied so as to change the orientation of the magnetic particles, the claim is believed to be patentable over the cited combinations.

Furthermore, a person skilled in this art would not combine the teachings of *Easterlow* and *Chu* for at least the following reasons. In *Easterlow*, the metallic flakes align with the direction of flow of the molding layer during its formation, as described in paragraphs 7-9 of applicant's specification. Accordingly, the metallic flakes are already oriented parallel to the exterior surface of the molding. The only reason that *Chu* uses a magnetic field is to orient the magnetic flakes in the spray coating parallel to the exterior surface of the housing. (See *Chu* at col. 8:7-14). This is a necessary step since the metallic flakes are applied in a spray coating, rather than by injection molding, and thus the flakes are randomly oriented. As the metallic flakes in *Easterlow* are already oriented parallel to the exterior surface, there is no benefit, and certainly no motivation, to use the magnetic field disclosed in *Chu*. Even if one did use the magnetic field disclosed in *Chu* to modify *Easterlow*, the orientation of the metallic flakes would not be altered since they are already parallel to the surface. Accordingly, the skilled artisan would not be motivated to combine the teachings of *Easterlow* and *Chu*, and even if they did, there would be no change in the orientation of the magnetic particles.

The Examiner also rejected claim 56 on another basis, namely, that it is obvious over *Easterlow* and *Chu* as further combined with *Kashiwagi*. However, *Kashiwagi* is not more relevant than *Chu* since it also discloses a spray coating process, and for all the reasons already discussed, claim 50 as amended is believed to be patentable over the cited combination.

Claims 51-55 and 57-84 are dependent through claim 50 and considered patentable for all the same reasons.

The Examiner has cited numerous other references to form rejections of the

various dependent claims, but applicant submits that these references are no more relevant than those discussed herein.

III. CONCLUSION

Based on the remarks above, reconsideration and allowance of the pending claims is respectfully requested. The Examiner's prompt attention to this matter is greatly appreciated. Should further questions remain, the Examiner is invited to contact the undersigned attorney by telephone.

Enclosed is a PETITION FOR EXTENSION OF TIME UNDER 37 C.F.R. § 1.136 for extending the time to respond up to and including today, June 4, 2009.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 501826 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

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